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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/145,916 09/02/98 SIMONS M BIS-039

EXAMINER

HM12/0124

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MAGNOLIA MA 01930

GUZO, D	
ART UNIT	PAPER NUMBER

1636

DATE MAILED:

01/24/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/145,916

Applicant(s)

Simons et al.

Examiner

David Guzo

Group Art Unit

1636



☒ Responsive to communication(s) filed on Nov 15, 1999

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-19 is/are pending in the application

Of the above, claim(s) 18 is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-17 and 19 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s) _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

☒ Notice to Comply with Sequence Rules

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. Applicant's election with traverse of Group I, claims 1-13 and 19 in Paper No. 5 is acknowledged. The traversal is on the ground(s) that claims 1-19 represent a single inventive concept and separation of the claims into *in vivo* and *in vitro* embodiments is arbitrary.

Applicants indicate that the restriction of claim 18 as a different invention is a meaningless effort since it creates an additional burden of effort which is a duplication in substance of the prior art search. This is not found persuasive because the restriction requirement properly concludes that the two inventions are distinct and are related as product and process of use and that the product of Group I can be used in materially different processes from that recited in Group II. A search of the two Groups would be burdensome since the two Groups are classified in different classes and subclasses and a search of the two Groups would not be co-extensive.

The requirement is still deemed proper and is therefore made FINAL.

2. Claim 18 is withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 5.

This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures.

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Applicant must comply with the sequence rules, 37 CFR 1.821 - 1.825. Failure to comply with these requirements will result in ABANDONMENT of the application under 37 CFR 1.821(g). Applicant is requested to return a copy of the attached Notice to Comply with the reply. The nature of the non-compliance has not however precluded an examination of the application on the merits, the results of which are communicated below.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-17 and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 2, 12, 13, 14 (and dependent claims) are vague in the recitation (in lines 6, 12 and 21 of claim 1; in lines 6-7, 12-13 and 22 of claim 2; in line 22 in claim 12; in line 21 of claim 13 and in line 19 of claim 14, etc.) of the phrase "...of a transfected endothelial cell.." or "...by a transfected endothelial cell..." since these phrases do not indicate which "transfected endothelial" cells are being referred to, i.e. are the endothelial cells being referred to cells transfected with the recited prepared DNA molecules or any transfected endothelial cells. Redrafting the claims to indicate that the transfected endothelial cells are the cells transfected with the recited DNA segments.

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Claim 3 is vague in the recitation of the phrase "...and positions on the proteoglycan entities at the cell surface...". It is unclear what is positioned on the proteoglycan entities at the cell surface.

Claim 9 is vague in that applicants claim a *in-situ* transfected endothelial cell wherein the cell exists under *in vivo* conditions. It is unclear how a cell which exists *in vivo* differs from the same cell *in vitro* or under any other conditions. Also, the scope of the claimed subject matter is unclear because the cell is claimed in the context of its *in vivo* surroundings wherein the environment of the cell is essential to survival of the cell. Therefore, it is unclear what portion of the *in vivo* environment (i.e. some or all of the animal (human) which comprises the recited cell) is claimed.

It is noted that applicants have misspelled heparin as "heparan" throughout the claims.

Correction is required.

No Claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Guzo whose telephone number is (703) 308-1906. The examiner can normally be reached on Monday-Thursday from 8:00 AM to 5:30 PM. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott, can be reached on (703) 308-4003. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4242 or (703) 305-3014.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

David Guzo
January 20, 2000

DAVID GUZO
PRIMARY EXAMINER

A handwritten signature in cursive script, reading "David Guzo", written in black ink.